

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL E. MILLER

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Appeal No. 2000-0926  
Control No. 90/004,991<sup>1</sup>

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HEARD: DECEMBER 6, 2000

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Before CALVERT, ABRAMS and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19, which are all of the claims pending in this reexamination proceeding.<sup>2</sup>

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<sup>1</sup> Reexamination of U.S. Pat. No. 5,669,622.

<sup>2</sup> Appellant filed an amendment (Paper No. 17) subsequent to the final rejection. Although the examiner clearly indicated (Paper Nos. 18 and 19) that the amendment would not be entered, we note that it has been clerically entered. As both the examiner and appellant agree that the amendment has not been approved for entry (brief, page 2; answer, page 2), we have treated the amendment as not having been entered. However, the examiner should take

(continued...)

BACKGROUND

The appellant's invention relates to a telemark ski binding. Claim 10 is illustrative of the invention and reads as follows<sup>3</sup>:

10. A telemark ski binding for mounting a boot having a sole, a heel and a toe to a ski, the binding comprising:

means for fixedly connecting the toe of the boot to the ski;

a cable tensioned around the heel of the boot yet permitting the boot heel to be raised off of the ski an extent sufficient to perform a telemark ski turn;

a cable guide, mountable together with said toe connecting means on an upper surface of the ski for controlling a position toward which said cable is tensioned, said cable guide for receiving said cable therein below said boot sole to generate increasing cable tension, urging the boot heel back down onto the ski as it is raised off the ski; and

wherein said cable guide is positioned to restrain said cable to travel beneath the boot sole in a direction from the fixed toe toward the boot heel both when the boot heel is on a top surface of

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<sup>2</sup>(...continued)  
appropriate action to have the clerical entry of the amendment reversed.

<sup>3</sup> The claims in the appendix to appellant's appeal brief contain minor errors, in that underlining and bracketing is not provided to show the language respectively added to and deleted from the patent claims (37 CFR § 1.530(d)(2)(i)(A)).

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the ski and when the boot heel is raised off the top surface of the ski.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Refsdal	2,183,171	Dec. 12,
1939		
Rauglas	2,199,444	May 7,
1940		

The following rejection is before us for review.

Claims 1-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Refsdal in view of Rauglas.

Reference is made to the brief (Paper No. 21) and the answer (Paper No. 22) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims<sup>4</sup>, to the applied prior art references, and to the

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<sup>4</sup> We note an inconsistency between the preamble and the body of claim 17. Specifically, the preamble indicates the claim is directed to the binding only (i.e., the ski is not part of the claim). However, the claim further recites a cable guide "mounted together with said toe connecting means on an upper surface of the ski," which suggests that the ski is part of the claimed invention. In the event of further proceedings before the examiner, appellant should consider amending claim 17 to resolve this inconsistency.

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respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's brief does not present arguments as to why the claims are separately patentable. Therefore, in accordance with 37 CFR § 1.192(c)(7), we have selected claim 10 as the representative claim to decide the appeal on the rejection of claims 1-19 under 35 U.S.C. § 103.

Refsdal, the primary reference relied upon by the examiner in rejecting the claims, discloses a ski binding comprising a toe iron 2, 2' or 3, 3' which may be provided with clamps, brackets or the like (not shown) for securing the toe of the boot sole to a ski; a cable (steel wire 4, 5) tensioned by means of a suitable tightening device (not shown) around the heel of the boot to form a heel strap; and a cable guide (channel shaped depressions 6, 6'). As disclosed in column 1, lines 15-19, "the front members of the heel strap will be located at least at the rear part of the toe irons below the sole of the boot, i.e., between the sole of the boot and the horizontal part of the toe irons."

The examiner finds that Refsdal lacks the exact disclosure of the toe clamp in the toe iron, but takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the toe iron of Refsdal with a strap and recess for holding the toe down as taught by Rauglas (answer, page 4). Appellant (brief, pages 6-7) argues that the teachings of Refsdal and Rauglas are divergent, in that, while Refsdal teaches promoting upward movement of the boot heel with low resistance, Rauglas teaches prohibiting upward movement of the boot heel completely. Thus, according to appellant, combining the references is illogical and, therefore, improper.

Even if appellant is correct that Rauglas teaches prohibiting upward movement completely, while Refsdal permits upward movement of the heel, we do not agree with appellant that this difference would have taught away from the modification (provision of a toe strap and recess in the toe iron of Refsdal for holding the toe down) proposed by the examiner. As to the specific question of "teaching away," our reviewing court in In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated:

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A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Simply that there are differences between two references is insufficient to establish that such references "teach away" from any combination thereof. See In re Beattie, 974 F.2d 1309, 1312-13, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

In this instance, the toe irons and associated strap of Rauglas, like the toe irons and associated clamps, brackets or the like of Refsdal, are intended to clamp the toe of the ski boot down against the top surface of the ski. Thus, we find ourselves in agreement with the examiner that it would have been obvious to provide a toe strap and associated recesses in the toe irons of Refsdal to accommodate the toe strap, as taught by Rauglas, to serve as the clamps, brackets or the like of Refsdal for gripping the toe of the boot against the ski.<sup>5</sup>

Appellant further argues that, even if Refsdal and Rauglas were combined as proposed by the examiner, the

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<sup>5</sup> In fact, appellant's counsel conceded this point at the oral hearing.

references would still not suggest the appellant's invention. In particular, appellant argues that neither reference discloses that the cable guide should be positioned so as to restrain the cable to travel beneath the sole of the boot both when the boot heel is on the top surface of the ski and when the boot heel is raised off the top surface of the ski and so as to generate increasing tension, as required in each of the independent claims (brief, pages 5 and 7-9).

The claimed features referred to by appellant are best illustrated in Figures 2 and 3 of appellant's patent. As explained in column 4, lines 10-24, because appellant's cable 36 travels beneath and within the width of the ski boot (note Figure 3), when the boot heel 38 is raised off of the ski surface, boot sole flex is minimized and cable tension increases. This is in contrast to the prior art binding 90 shown in Figures 7 and 8, in which the cable 36 travels outside the width of the boot and thus is free to travel above the boot sole 24 such that tension in the cable 36 promotes flexing of the boot sole and provides a force for raising the boot off the ski top surface (column 3, lines 56-64).

As noted above, the front members of the heel strap of Refsdal are, like appellant's cable, located, at least at the rear part of the toe irons, below the sole of the boot, i.e., between the sole of the boot and the horizontal part of the toe irons (column 1, lines 15-19). Accordingly, we conclude that the examiner has provided a reasonable basis to support the determination that the cable guide of Refsdal is positioned to restrain the cable (heel strap) to travel beneath the boot sole in a direction from the fixed toe toward the boot heel both when the boot heel is on a top surface of the ski and when the boot heel is raised off the top surface of the ski and to generate increasing cable tension, urging the boot heel back down onto the ski as it is raised off the ski, so as to shift the burden to appellant to prove that this is not the case. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Appellant has not come forward with any evidence to satisfy that burden. Appellant's mere argument on page 8 of the brief that the Refsdal design allows the cable (heel strap) to travel on either side of the boot above the boot sole, thus promoting

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flexing of the boot sole, is not evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence).

With regard to the claim limitation "to generate increasing tension, urging the boot heel back down onto the ski as it is raised off the ski," we are cognizant of Refsdal's statement that, with the inventive ski binding disclosed therein, "the pivot points of the heel strap will be placed further forwards, whereby less resistance is made against the vertical movement of the heel" (column 1, lines 20-23). However, the reference to "less resistance" is made relative to a different prior art arrangement wherein the heel strap passes below the toe irons over the entire length of the toe irons (column 1, lines 5-10). Refsdal's binding is an improvement over such an arrangement, in that it places the pivot point of the heel strap further forward, thereby decreasing the resistance to vertical movement of the heel. This in no way suggests that the resistance of the heel strap decreases as the boot heel is raised off the ski.

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For the reasons discussed above, we shall sustain the examiner's rejection of representative claim 10, as well as claims 1-9 and 11-19 which fall therewith.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-19 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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